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ULM, J	

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DATE MAILED: 07/08/92

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

~~☐~~ This application has been examined ~~☐~~ Responsive to communication filed on 04/30/92 ~~☒~~ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ~~☒~~ Claims 1 to 14, 24 to 34, and 39 to 59 are pending in the application.
   Of the above, claims 58 is/~~are~~ withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ~~☒~~ Claims 1 to 14, 24 to 34, 39 to 57, and 59 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER

Claims 1 to 14, 24 to 34, 39 to 57, and newly submitted claims 58 and 59 are pending in the instant application. Newly submitted claim 58 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 58 is drawn to a method of using a DNA construct which includes a part of the DNA of the other pending claims. These inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the DNA claimed can be used in a materially different process such as in the production of the encoded protein or as a probe for the detection of the presence of related nucleic acids in a sample.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 58 is withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 to 14, 24 to 34, and 39 to 57 stand, and newly

submitted claim 59 is rejected under 35 U.S.C. § 103 as being unpatentable over the Petrovich et.al. publication in view of the Hauptmann et.al. and Krust et.al. publications for reasons of record.

Applicants have characterized the instant invention as relating to an isolated DNA of the hap gene. Applicant's have not addressed the fact that the hap gene encodes a steroid hormone related retinoic acid receptor having approximately 90% sequence similarity to the isolated DNA described in the Petrovich et.al. reference as encoding a retinoic acid receptor.

Contrary to Applicants' assertion, the previous Office Action did not indicate that the Petrovich et.al. reference does not suggest the instant invention. In fact, these claims have been rejected because the Petrovich et.al. reference does suggest the instant invention in view of a contemporary knowledge of the art of molecular biology as exemplified by the Hauptmann et.al. reference. The Discussion section of the Petrovich et.al. reference specifically suggests that "[t]he approach used here to clone hRAR could obviously be used to isolate further members of the nuclear receptor multigene family which may be expressed in embryonic or adult tissues." This reference further states that [t]he finding that, in human hepatoma, the hepatitis B virus genome is inserted into a genomic sequence (hORF) closely related to that of the hRAR gene raises the possibility that altered retinoid receptors may have oncogenic properties." It is clear

that the Petrovich et.al reference more that suggested the instant invention because one of ordinary skill would have found the isolation of a cDNA corresponding to hORF as described in the Related human genomic sequence section of this reference, which is the instant invention, to have been virtually anticipated by this reference.

Applicant's arguments filed 30 April of 1992 have been fully considered but they are not deemed to be persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to John D. Ulm at telephone number (703) 308-4008.

DAVID L. LACEY
SUPERVISORY PATENT EXAMINER
GROUP 180
7/7/92